

REMARKS / ARGUMENTS

I. General Remarks and Disposition of the Claims.

Claims 1, 5-30, 34-40, and 87-113 are pending in this application. Claims 1, 14-17, 22-23, 29-30, 90, 100-103 and 113 have been amended herein. Claims 13 and 99 have been cancelled. Applicants respectfully request that the above amendments be entered and request reconsideration in view of the remarks contained herein. Applicants thank the Examiner for his careful consideration of this application.

II. Remarks Regarding the New Matter—Objection to the Specification

Applicants' amendments to paragraphs 18, 19, 20, and 21 presented in their November 14, 2005 Response were objected to as "a new matter deletion." (Office Action at 2.) Applicants submit that these amendments are not a new matter deletion, and therefore, Applicants traverse.

Under 35 U.S.C. 132(a), new matter cannot be introduced into the disclosure, and new matter is "[m]atter not in the original specification, claims, or drawings." MPEP § 608.04(a). "Stated another way, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." MPEP § 2163.06. Applicants' amendments are supported by the original disclosure because the original disclosure discloses hydrolyzed protein in both the specification (*see, e.g.*, original application ¶ 19) and original claims (*see, e.g.*, original application, claims 3-5). None of the amendments to paragraphs 18, 19, 20, or 21 added new matter. *See* MPEP § 2163.07 ("Amendments to an application which are supported by the original description are NOT new matter.") Accordingly, Applicants respectfully request withdrawal of the objection to the specification.

III. Remarks Regarding the 35 U.S.C. § 112, Second Paragraph Rejection

Claims 1, 5-30, 34-40, and 87-113 stand rejected under 35 U.S.C. § 112, ¶ 2, as failing to set forth the subject matter which Applicants regard as their invention because the term "desired" in claims 1 and 87 and the term "low density cement" in claim 24 and 109 are indefinite. (Office Action at 2-3.)

With respect to the term "desired," the Examiner states, "[d]esired is synonymous to predetermined and its meaning is indefinite," (Office Action at 3) and that predetermined "has been held in earlier decisions to be indefinite." (Office Action at 8). Although Applicants

believe that this language is sufficiently definite to meet the requirements of 35 U.S.C. § 112, Applicants have amended the language in claims 1 and 87 per the Examiner's preference. Accordingly, Applicants respectfully request the withdrawal of this rejection.

With respect to the term "low," the Examiner states that "[t]he term 'low' is a relative and indefinite term and applicants have not defined what they mean by 'low' density cement by showing a numerical means so it is clear for the record." (Office Action at 3.) At the outset, Applicants request withdrawal of the 35 U.S.C. § 112, ¶ 2 rejection for all claims other than 24 and 109 because these claims do not include, nor do these claims depend from a claim that includes, the term or "low." Applicants continue to traverse the rejection of claims 24 and 109 for the reasons asserted in their March 27, 2006 Response, and assert that this language is sufficiently definite to satisfy 35 U.S.C. § 112, ¶ 2. Applicants again emphasize that claim language is sufficiently definite under 35 U.S.C. § 112, ¶ 2 if "one of ordinary skill in the art would understand what is claimed" by that language. MPEP § 2173.05(b). There is nothing in Applicants' disclosure, nor are Applicants' aware of anything in the prior art, that gives rise to uncertainty about the scope of claims 24 and 109. *See* MPEP § 2173.05(c) (citing *Ex parte Skuballa*, 12 U.S.P.Q.2d 1570 (BAPI 1989)). Among other things, Applicants' disclosure states that "[s]uch low density cements may be foamed cements or may be cements comprising another means to reduce their density such as hollow microspheres, low-density elastic beads, or other density-reducing additives known in the art." (Application ¶ 14.) Applicants' use of the term "low" is in accordance with the prior art cited by the Examiner. *See, e.g., Sugama* col. 1, ll. 21-24 ("One object of the present invention is to provide low density cement slurries."); *Etherton*, Abstract ("A process and apparatus for producing a low density foam concrete."). Thus, the term "low" is definite.

For the foregoing reasons, Applicants submit that claims 1, 5-30, 34-40, and 87-113 satisfy 35 U.S.C. § 112, ¶ 2 and therefore, request withdrawal of the 35 U.S.C. § 112, ¶ 2 rejection.

IV. Remarks Regarding the Obviousness Rejections

Claims 1, 5-30, 34-40, and 87-113 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sugama*, *Gay*, *Neely*, or *Etherton* alone or in view of *Chatterji*, *Bour*, *Cattanach*, *Gopalkrishnan*, or *DiLullo Arias*. (Office Action at 3-7.) Applicants traverse the rejection of claims 1, 5-30, 34-40, and 87-113, and submit that the Examiner has not shown that

the cited references teach each and every element recited in claims 1, 5-30, 34-40, and 87-113 as required to form a *prima facie* case of obviousness under 35 U.S.C. § 103(a). MPEP 2142.

In particular, none of the cited references teach or suggest the recitation of a “dispersant composition comprising a surfactant, a hydrolyzed protein, and a defoamer” (independent claims 1, 30, and 90), the method step of “allowing the dispersant composition to disperse at least some of the cement composition” (independent claims 1 and 30), or the method step of “allowing the dispersant composition to reduce the apparent viscosity of the cement composition” (independent claim 90). However, the Examiner states that:

Gopalkrishnan '128 teaches it is old to add defoamers to cement compositions such as well cement compositions and even includes polypropylene glycol as a defoamer (col. 6, line 54) which is the same defoamer as claimed by applicants' claim 14).

(Office Action at 5). Applicants disagree. *Sugama*, *Gay*, and *Etherton* are directed to foamed compositions. Thus, adding a defoamer to these compositions would be contrary to their teachings and objectives. Similarly, Applicants submit that *Neely* does not teach using a hydrolyzed protein in combination with a defoamer and a surfactant as a dispersant composition in methods of cementing as recited in independent claims 1, 30 and 90. *Neely* does not teach cement compositions but instead teaches “coating compositions” that may comprise surfactants, hydrolyzed proteins, and a defoamer only when they are used to coat stainless steel (*Nelly*, col. 6, ll. 3-9, col. 7, ll. 11-16). Thus, Applicants respectfully assert that independent claims 1, 30 and 90 and its dependents are not obviated by the cited references.

Finally, as provided in MPEP § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a *prima facie* case of obviousness. The Examiner cites no reference or teaching in the prior art to support his statement as to the supposed motivation of a person of ordinary skill in the art. To the extent that the Examiner relies on such a statement to supply the necessary motivation to modify the prior art reference, Applicants hereby respectfully traverse the lack of such a showing and request under MPEP § 2144.03(C) that the Examiner supply an affidavit or other documentary proof establishing the prior art knowledge that would have motivated a person of ordinary skill in the art to use the dispersant composition specified in Applicants' invention.

V. Remarks Regarding the Obviousness-Type Double Patenting Rejection

Claims 1, 5-30, and 34-40 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 52 of *Reddy I* (U.S. Pat. No. 6,454,004) and *Reddy II* (U.S. Pat. No. 6,793,730) alone or in view of *Cattanach* (U.S. Pat. No. 3,615,784 or FR 1550231).

The standard for a double patenting rejection is whether the claim in the application is an obvious variation of an invention claimed in the patent. MPEP § 804(B)(1). Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly-owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. This double patenting analysis is confined to a comparison to the claims in the patent, and not to use of the disclosure of the patent as prior art. *See* MPEP § 804(III).

The claims of the present invention include the following limitations: providing a cement composition comprising a cement, and a dispersant composition, the dispersant composition comprising a surfactant, a hydrolyzed protein, and a defoamer (claim 1); adding to the cement composition a dispersant composition comprising a surfactant, a hydrolyzed protein, and a defoamer (claim 30); and allowing the dispersant composition to disperse at least some of the cement composition (claims 1 and 30). Applicants respectfully assert that the claims of *Reddy I* and *Reddy II*, alone or in view of *Cattanach*, have not been shown to refer to a dispersant composition and dispersing cement. The Examiner simply has not shown any aspect of the invention in *Reddy I* and *Reddy II*, alone or in view of *Cattanach*, to include these limitations. Therefore, the Examiner has not shown that the claims of the present invention fail to be patentably distinct from the claims of *Reddy I* and *Reddy II*, alone or in view of *Cattanach*. Because Applicants' claims contain limitations not claimed in *Reddy I* and *Reddy II*, alone or in view of *Cattanach*, Applicants respectfully submit that the claims of the present invention are patentably distinct from the claims of *Reddy I* and *Reddy II*, alone or in view of *Cattanach*. Applicants respectfully requests withdrawal of the obviousness-type double patenting rejection as to claims 1, 5-30, and 34-40, and the timely issuance of a Notice of Allowance for these claims.

IV. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinction discussed by Applicant is sufficient to overcome the anticipation and obviousness rejections.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants hereby petition under the provisions of 37 C.F.R. § 1.136(a) for a one-month extension of time to file this Response, up to and including May 25, 2006. Applicants have included the appropriate fee of \$790.00 for the RCE fee under 37 C.F.R. § 1.17(e) as required by 37 C.F.R. § 1.114, and the appropriate fee of \$120.00 for a one-month extension of time under 37 C.F.R. § 1.136. Applicants believe that there are no additional fees due in association with this filing of this Response. However, should the Commissioner deem that any fees are due, Applicants respectfully request that the Commissioner accept this as a petition therefor, and direct that any additional fees be charged to Baker Botts L.L.P.'s Deposit Account No. 02-0383 (Reference Number 063718.0341).

Respectfully submitted,

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